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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,822	03/17/2004	Hiroyuki Kimbara	250564US2	2522
22850	7590	09/08/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LEWIS, CHERYL RENE	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/801,822	<b>Applicant(s)</b> KIMBARA ET AL.	
	<b>Examiner</b> Cheryl Lewis	<b>Art Unit</b> 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/30/04 & 2/25/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-78 are presented for examination.

### ***Information Disclosure Statement***

2. The information disclosure statement filed July 30, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The applicants have not provided a copy of the foreign patent document 2002-84383, Japanese, dated May 22, 2002.

3. The information disclosure statement filed February 25, 2005 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in

Art Unit: 2167

the application file, but the information referred to therein has not been considered.

The applicants have not provided a copy of references 10/801822 and 11/009415 listed on a PTO-1449 that should be listed (cited) on this document and to be considered by the Examiner.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 9, 10, 18, 19, 27, 28, 29, 37, 38, 39, 40, 41, 43-45, 46-49, 50, 51, 52, 53, 54- 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Copeland et al. (Pat. No. 5,659,613 filed June 7, 1995, hereinafter Copeland).

6. Regarding Claims 1, 10, 19, 29, 39, and 40, Copeland teaches a method and apparatus for copy protection for various recording media using a video finger print.

The method and associated system for copy protection for various recording media using a video finger print as taught or suggested by Copeland includes:

a detector that detects a recording medium (col. 6, lines 1-41 and 61-67);  
a recording-medium starting section that activates the recording medium

Art Unit: 2167

detected by the detector to be in an accessible state; (col. 6, lines 1-41 and 61-67); and a program starting section that performs an authentication check on recording medium (col. 6, lines 38-60), reads a program from a recording medium when a result of the authentication check is normal (col. 6, lines 61-67, col. 7, lines 1-29), and starts an execution of a program (col. 6, lines 61-67, col. 7, lines 1-29).

7. Regarding Claims 9, 18, 27, 37, 41, 52, the limitations of these claims have been noted in the rejections of claims 1, 10, 19, 29, 39, and 40 presented above. In addition, Copeland teaches means for monitoring a plug and play of the recording medium with respect to a slot (col. 7, lines 8-38).

8. Regarding Claims 28, 38, and 53, the limitations of these claims have been noted in the rejections of claims 1, 10, 19, 29, and 39 presented above. In addition, Copeland teaches hardware resources used in an image forming process (figure 1, element 22 and figure 2, element 42) and relating the image formation (figure 1, element 22 and figure 2, element 42).

9. Regarding Claims 43-45, 50, and 51, the limitations of these claims have been noted in the rejections of claims 1, 10, 19, 29, 39, and 40 presented above. They are therefore rejected as set forth above.

10. Regarding Claims 46-49, the limitations of this claim have been presented in the rejections of claims 1, 10, 19, 29, 39, and 40 presented above. In addition, Copeland teaches an electronic signature (col. 6, lines 48-54).

11. Regarding Claim 54, Copeland teaches producing an updating program for updating a program which information processing apparatus is caused to start

Art Unit: 2167

(col. 6, lines 1-41 and 61-67) and recording the produced updating program on updating recording-medium (col. 6, lines 1-41 and 61-67).

12. Regarding Claim 55-78, the limitations of these claims have been noted in the rejections above. They are therefore rejected as set forth above.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2-8, 11-17, 20-26, and 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copeland et al. (Pat. No. 5,659,613 filed June 7, 1995, hereinafter Copeland) as applied to claims 1, 10, 19, 29, 30, and 40 above, and further in view of Otsuka (Pat. No. 6,243,796 B1 filed July 31, 1997, hereinafter Otsuka).

15. Regarding Claims 2, 11, 20, and 30, Copeland teaches the program starting section reads for authentication check from a recording medium in an accessible state (col. 6, lines 61-67, col. 7, lines 1-29). However, Copeland does not expressly teach using a file.

Otsuka teaches using a file (col. 4, lines 46-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the recording medium of Copeland's method

Art Unit: 2167

with the recording medium of Otsuka's method because Otsuka's recording medium could enable the recording medium of Copeland to include a file, wherein the file enables data to be written into a rewritable area of the file to an effort to perform logical formatting to a disk which has been physically formatted.

16. Regarding Claims 3, 12, 21, and 31, the limitations of these claims have been noted in the rejections of claims 1, 2, 10, 11, 19, 20, 29, 30, and 40 presented above. It is therefore rejected as set forth above.

17. Regarding Claims 4, 13, 22, and 32, the limitations of this claim have been presented in the rejections of claims 1, 10, 19, 29, 39, and 40 presented above.

In addition, Copeland teaches an electronic signature (col. 6, lines 48-54).

Otsuka teaches identification information (col. 3, lines 63-67).

18. Regarding Claims 5-8, 14-17, 23-26, 33-36, the limitations of these claims have been noted in the rejections of claims 1, 10, 19, 29, 39, and 40 presented above. They are therefore rejected as set forth above.

#### **NAME OF CONTACT**

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2167

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Lewis  
Patent Examiner  
September 5, 2006